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NEIFELD IP LAW, PC  
2001 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/513,960

Applicant(s)

PLOTKIN, JOEL FREDERIC

Examiner

Igor Borissöv

Art Unit

3629

*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

The amendment filed on August 22, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The material, added into new **claims 29, 30 and 32-34**, which is not supported by the original disclosure, is as follows:

**Claim 29.** "... has *rights* to assign.."; "... does not have *rights* to assign..";

**Claim 30.** "... has *less rights*...";

**Claims 32 and 34.** "... storing *different rights*..";

**Claim 33.** "... has *rights* to get status..."; "... has *rights* to assign.."; "... does not have *rights* to assign.."; "... has *rights* to indicate...".

The specification is completely silent about any *rights*, and discloses only *roles* and *tasks* to be assigned. The term "*rights*" implies ability to execute certain actions and does not require said certain actions to be performed, while the terms "*roles*" or "*tasks*" convey obligatory meaning of said certain actions to be performed. Therefore, the use of the term "*rights*" introduces new matter into the disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

**Claims 3 and 13** have previously been canceled. **Claims 1, 5, 11, 15 and 20** have been amended. New **claims 25-34** have been added. **Claims 1-2, 4-12 and 14-34** are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 29, 30 and 32-34 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The material, added into new **claims 29, 30 and 32-34**, which is not disclosed in the specification, is as follows:

**Claim 29.** "... has *rights* to assign.."; "... does not have *rights* to assign..";

**Claim 30.** "... has *less rights*...";

**Claims 32 and 34.** "...storing *different rights*..";

**Claim 33.** "... has *rights* to get status..."; "... has *rights* to assign.."; "... does not have *rights* to assign.."; "... has *rights* to indicate...".

The specification is completely silent about any *rights*, and discloses only *roles* and *tasks* to be assigned. The term "*rights*" implies ability to execute certain actions and does not require said certain actions to be performed, while the terms "*roles*" or "*tasks*" convey obligatory meaning of said certain actions to be performed. Therefore, the use of the term "*rights*" introduces new matter into the disclosure.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-2, 4-10, 21-25 and 29-30 rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process,

machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

*The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is*

*presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.*

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

The claims of the present application are distinguished from the claims analyzed in the decisions of *State Street*, *Alappat*, *Arrhythmia* and *AT&T*, where the claims in these cases clearly involved the use of technology as shown below.

**State Street:** The claims were in means plus function form and directed to a data processing system for managing a financial services configuration of a portfolio established as a partnership; the claims included limitations of a computer processor means for processing data, a storage means for storing data on a storage medium along with first through fifth means for processing different types of financial data. As such, the claims analyzed in *State Street* clearly involved the technological arts and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**AT&T Corp:** The claims were directed to a method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber comprising generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. In considering these claims, it is clear that technology is being used to "automatically route" calls over the facilities of interexchange carriers and generating a message record for the call. Furthermore, the courts, in analyzing these claims, clearly indicated that they recognized the claims require the use of switches and computers. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1450 (Fed. Cir. 1999). The court further noted that AT&T's claimed process employs subscriber's and call recipients' PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through *switching and recording mechanisms* to create a signal useful for billing purposes. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1453 (Fed. Cir. 1999). As such, the claims analyzed in AT&T clearly involved the technological arts as recognized

by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**Alappat:** The claims were directed to a rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising various means for determining distances and means for outputting illumination intensity data. Alappat's invention related generally to a means for creating a smooth waveform display in a digital oscilloscope and as indicated by the court, Alappat's invention is an improvement in an oscilloscope comparable to a TV having a clearer picture. The court reasoned that invention was statutory because the claimed invention was directed to a "machine". See *In re Alappat*, 31 USPQ2d at 1552-54 (Fed. Cir. 1994). Furthermore, in the decision of *AT&T Corp.*, the courts recognized that the claims in Alappat were for a machine that achieved certain results. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 50 USPQ2d at 1452 (CAFC 1999). Once again, these claims clearly involve the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**Arrhythmia:** The claims were directed to a method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal including the step of converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time. In considering these claims, it is clear that technology is being used to convert a series of QRS signals to time segments having a digital value. Once again, these claims clearly involve the technological arts since one could not convert a signal to a time segment having a digital value without the aid of a computer or some processing device and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Contrary to the claims in the above-cited cases, in the present application, **claims 1-2, 4-10, 21-25 and 29-30** are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The claims are no more than a suggested idea of



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assigning an editor to review a manuscript, and, based on reviewing results making a decision should the manuscript be published or not. The method step of: *receiving (transmitting) manuscript data defining a manuscript including at least one of text data, audio data, and video data* may be understood as merely giving a diskette having file stored thereon to a person. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although *Bowman* is not precedential, it has been cited for its analysis.

Furthermore, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data. The claims merely determine *receiving manuscript data, reviewing said data, and storing a decision whether to publish*, wherein said *decision* appears to be an abstract value which is arbitrarily set by a human and not a result of an algorithm performed by a computer or processor specifically calculating said *decision*. Thus, there neither appears to be any physical transformation of data from one form to another which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) a network system, or mere implication of employing a

machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

As to "wherein" clause, it merely states the intended use of the invention, or the result of the limitations in the claim, and adds nothing to the patentability of the claim. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 4-12, 14-27 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plantz et al. (U. S. 6,088,702) (Plantz) in view of Hager et al. (U. S. 5,377,355) (Hager).**

Plantz teaches a method and system for permitting coordinated publishing, assembly and administration of texts by an unlimited number of authors or editors, comprising:

As per **claims 1, 11 and 20**,

- receiving manuscript data defining a manuscript comprising at least one of text data, audio data, and video data (column 7, lines 37-43, 58-63; column 8, lines 20-27; column 9, lines 24-31);
- prompting a potential reviewer for agreement to review said manuscript (column 8, lines 20-30);
- storing agreement data received from said potential reviewer (column 8, lines 20-30, 59-67; column 10, lines 1-13).

Plantz does not specifically teach *storing a decision whether to publish*.

Hager teaches a method and system for automatically initiating additional procedures with regard to a document, wherein evaluators vote to publish the document, and a decision whether to publish is stored (column 2, lines 39-53; column 7, lines 20-21; column 7, line 48 through column 8, line 1; column 8, lines 44-51; column 9, lines 48-57).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Plantz to include storing a decision whether to publish, as disclosed in Plantz, because it would advantageously allow to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

Furthermore, Plantz teaches:

As per **claims 2 and 12**, transmitting a signal prompting an additional potential reviewer for agreement to review said manuscript based on stored agreement data from at least one potential reviewer (column 8, lines 59-67).

As per **claims 4 and 14**, adding an identification of a new editor for said manuscript in association with said manuscript data (column 10, lines 8-36).

Furthermore, Plantz teaches that depending on the project, assigning editorial tasks would include assigning an executive editor and other editorial titles (column 10, lines 52-56). Information as to *associate editor* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381,

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1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Plantz in view of Hager would be performed the same regardless of the specific titles of assigned editors.

As per **claims 5 and 15**, storing at least one date on which said assigned editor assigns a potential reviewer (column 10, lines 12-14). Furthermore, Plantz teaches that depending on the project, assigning editorial tasks would include assigning an executive editor and other editorial titles (column 10, lines 52-56). Information as to *associate* editor is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

As per **claims 6 and 16**, storing a date on which at least one of receiving said manuscript, prompting a potential reviewer, and receiving agreement data occurs (column 10, lines 12-14, 46-62).

As per **claims 7-8 and 17-18**, authorizing transmission of said manuscript to at least one of assigned editors, potential reviewers and reviewers of said manuscript (column 10, lines 46-62). Furthermore, Plantz teaches that depending on the project, assigning editorial tasks would include assigning an executive editor and other editorial titles (column 10, lines 52-56). Information as to *associate* editor is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

As per **claims 9-10 and 19**, said method and system, wherein said authorizing transmission comprises storing, in association with said unique identification, an identification of the assigned editor and a reviewer (column 10, lines 30-62).

Furthermore, Plantz teaches that depending on the project, assigning editorial tasks would include assigning an executive editor and other editorial titles (column 10, lines 52-56). Information as to associate editor is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

As per **claim 21**, Plantz teaches that said manuscript can be published in print or in electronic form (downloaded) (column 1, lines 24-26). Hager teaches that said decision for publishing is final (column 5, line 22; column 9, line 11). The motivation to combine Plantz and Hager would be to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

As per **claim 22**, Hager teaches said method and system, wherein said decision for publishing is from different evaluators, and stored (column 2, lines 39-53). The motivation to combine Plantz and Hager would be to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

As per **claim 23**, Plantz teaches tracking said manuscript and storing said tracking information in a database (column 7, lines 1-2; column 11, lines 33-34).

Hager teaches determining whether evaluators votes have been received with regard to a particular document; and generating a prompting message to be utilized to induce an evaluator to submit a vote for the document if the evaluator has not done so within a preselected period of time (column 9, lines 27-37). The motivation to combine Plantz and Hager would be to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

As per **claim 24**, Hager teaches said method and system, wherein said final decision for publishing is made by a majority tallying of the individual reviews; and if all reviewers indicate said manuscript should be published, said manuscript is

automatically sent to a printing queue or printing facility (column 2, lines 39-53; column 7, lines 20-21; column 7, line 48 through column 8, line 1; column 8, lines 44-51; column 9, lines 48-57). The motivation to combine Plantz and Hager would be to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

Furthermore, Plantz teaches:

As per **claim 25**, prompting a potential reviewer for agreement to review said manuscript (column 8, lines 20-30).

As per **claim 26**, receiving manuscript data defining a manuscript comprising at least one of text data, audio data, and video data (column 7, lines 37-43, 58-63; column 8, lines 20-27; column 9, lines 24-31); prompting a potential reviewer for agreement to review said manuscript (column 8, lines 20-30).

As per **claim 26**, receiving manuscript data defining a manuscript comprising at least one of text data, audio data, and video data (column 7, lines 37-43, 58-63; column 8, lines 20-27; column 9, lines 24-31); prompting a potential reviewer for agreement to review said manuscript (column 8, lines 20-30).

As per **claim 27**, receiving manuscript data defining a manuscript comprising at least one of text data, audio data, and video data (column 7, lines 37-43, 58-63; column 8, lines 20-27; column 9, lines 24-31); prompting a potential reviewer for agreement to review said manuscript (column 8, lines 20-30). As per *automatically* prompting a potential reviewer..., it would have been obvious to include said "*automatically*" feature since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 420 USPQ 192.

As per **claims 29-30**, storing an identification data of the assigned editor for said manuscript in association with said manuscript data (column 9, lines 25-30; column 10, lines 8-36). Furthermore, Plantz teaches that a system administrator assigns (authorization to access) projects to authors and editors (column 7, lines 6-10; column 8, lines 23-27; column 10, lines 63-67). Furthermore, Plantz teaches that depending on the project, assigning editorial tasks would include assigning an executive editor and

other editorial titles (column 10, lines 52-56). Information as to *first*, *second* and *associate* editor is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

As per **claim 31**,

- receiving manuscript data defining a manuscript comprising at least one of text data, audio data, and video data (column 7, lines 37-43, 58-63; column 8, lines 20-27; column 9, lines 24-31);
- prompting a potential reviewer for agreement to review said manuscript (column 8, lines 20-30), thereby obviously indicating generating a request to review prompt for prompting said potential reviewer for agreement to review said manuscript;
- storing agreement data received from said potential reviewer (column 8, lines 20-30, 59-67; column 10, lines 1-13).

Plantz does not specifically teach *storing a decision whether to publish*.

Hager teaches a method and system for automatically initiating additional procedures with regard to a document, wherein evaluators vote to publish the document, and a decision whether to publish is stored (column 2, lines 39-53; column 7, lines 20-21; column 7, line 48 through column 8, line 1; column 8, lines 44-51; column 9, lines 48-57).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Plantz to include storing a decision whether to publish, as disclosed in Plantz, because it would advantageously allow to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

As per **claims 32-34**, storing an identification data of the assigned editor for said manuscript in association with said manuscript data (column 9, lines 25-30; column 10, lines 8-36). Furthermore, Plantz teaches that a system administrator assigns (authorization to access) projects to authors and editors (column 7, lines 6-10; column

8, lines 23-27; column 10, lines 63-67). Furthermore, Plantz teaches that depending on the project, assigning editorial tasks would include assigning an executive editor and other editorial titles (column 10, lines 52-56). Information as to *first*, *second* and *associate* editor is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

**Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plantz in view of Hager and further in view of Price et al. ("Peering Into Peer Review" (Price)).**

Plantz in view of Hager teach all the limitations of claim 28, including prompting a potential reviewer for agreement to review said manuscript (Plantz; column 8, lines 20-30), except specifically teaching prompting *another potential reviewer* for agreement to review said manuscript if a first potential reviewer *disagrees to review* said manuscript,

Price, which appears to be published on December 1995, discloses a current practice of reviewing manuscripts in science journals, wherein reviewers may decline the offer to review a manuscript (see pages 1 and 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Plantz and Hager to include that prompting another potential reviewer for agreement to review said manuscript if a first potential reviewer disagrees to review said manuscript, as disclosed in Price, because it would advantageously allow to fulfill the editing process even when one of more originally assigned to the task reviewers disagrees to review said manuscript, thereby allow the business to operate.



### ***Response to Arguments***

Applicant's arguments filed on August 22, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Plantz does not teach a *computer implemented manuscript review and determination process*, it is noted that Plantz specifically teaches a method and system for permitting coordinated or simultaneous publishing, assembly and administration of texts by any number of authors or editors, each of whom may perform word processing, document assembly and editing functions on the same or different portions of a group authored project. The output of the GPS is directly viewable, printable or downloadable in publishable format (C. 1, L. 10-26).

In response to applicant's argument that Hager does not teach storing a decision whether to publish, the examiner stipulates that Hager explicitly teaches this feature. Specifically, Hager teaches: "Line 114 of computer screen 110 illustrates the evaluation vote of the evaluator and requires the evaluator to enter an indication of his or her vote with regard to a particular disclosure. As illustrated, the evaluator ... may indicate that the invention disclosure *should be published or closed*, may indicate that he or she does not know what status should be assigned the invention disclosure, or may *abstain from the vote* (C. 7, L. 63 – C. 8, L. 4). After receiving an evaluation for an invention disclosure document, block 134 depicts the *storing of that evaluation*. The *evaluation of a particular invention disclosure document may be stored* at the evaluation facility, at the terminal of the Chairman of the Evaluation Committee, and/or at the disaster recovery site which has been utilized to store the backup copy of the invention disclosure document in question" (C. 8, L. 44-51).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Plantz and Hager relate to a method of reviewing and publishing of documents. The motivation to combine Plantz and Hager would be to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

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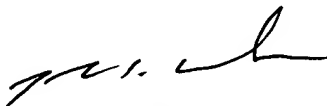
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IB

12/12/2004

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600